

REMARKS

1. Claim Rejections – 35 U.S.C. § 102

Claims 1-3, 9-11, 13, 15 and 36 have been rejected under 35 U.S.C. § 102(b) over *Altmann et al.* This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

In the rejection, the Examiner has noted one specific compound, namely compound 74C, of *Altmann et al.* as the basis for rejecting the claims. Applicants have amended the claims in a manner believed to obviate this rejection.

First of all, the Examiner will note that compound claim 1, has been amended to incorporate the limitations of claim 36. In addition, claim 1 now further includes a proviso which excludes the compound “H-Leu-Leu(CN)” which is specifically the compound 74C of *Altmann et al.* Thus, claim 36 now does not encompass compound 74C of *Altmann*.

The basis for the “proviso” clause added to claim 1 can be found at page 2, lines 30-31 of the Specification. That portion of the Specification specifically refers to the *Altmann et al.* WO 99/24460 publication, at page 50, paragraph C, and the publication is incorporated by reference at page 38, lines 4-6 of the Specification. Thus, amending the Specification to refer to the compound 74C in the background section of the application provides support for the proviso language in amended claim 1, which amendment serves to distinguish the compound claims over *Altmann et al.*

Secondly, with respect to the pharmaceutical composition claims, claim 24 has been amended to define the compound as in claim 36, and to additionally define that the composition is “suitable for administration to a patient”. Compound 74C of *Altmann et al.* is an intermediate compound in the preparation procedure of a different final product compound and is only described as being contained in fraction of a “yellowish oil”. Applicants submit that this “yellowish oil” intermediate product would not be suitable for administration to a patient, so that claim 24 distinguishes over even the disclosure *Altmann et al.* Applicants submit that the recitation in

claim 24 of the composition being “suitable for administration to a patient” provides a patentable distinction similar to the language “adapted for application to the human skin” found by the Board of Appeals to provide a patentable distinction for a cosmetic composition. See *Ex parte Conner*, 215 USPQ 384 (Pat. Off. Bd. App. 1981); See also *Ex parte Wittpenn*, 16 USPQ2d 1730 (Bd. Pat. App. & Int. 1990).

In view of the above, Applicants submit that the rejection of the claims over *Altmann et al.* should be withdrawn.

2. Claim Rejections – 35 U.S.C. § 112

Claims 20-23 have been rejected under 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Original claims 20-23 had been amended to be proper U.S. compound claims, dependent upon claims 1. It is believed that this action obviates the Examiner’s rejection.

3. Objections

The Examiner has objected to claims 1-26 as containing “non-elected subject matter”. Although the Applicants do not agree for this objection, as discussed above, claim 1 has been amended to incorporate the limitations of claim 36. Therefore, it is believed that this objection has been obviated.

In view of the above, reconsideration and withdrawal of the rejections and early allowance of all the claims are requested.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$130.00 is attached hereto.

Application No. 10/560,924
Amendment dated November 10, 2008
Reply to Office Action of July 10, 2008

Docket No.: 4614-0185PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

If the Examiner has any questions concerning this application, the Examiner is requested to contact Leonard R. Svensson, Reg. No. 30,330 at the telephone number of (858) 792-8855. Facsimile communications may be sent to the undersigned at the facsimile number of (858) 792-3785.

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Respectfully submitted,

By 

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